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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/616,856	07/09/2003	Olaf Kruse	3663-38	1796
7590	02/02/2006		EXAMINER	
Nicholas J. Tuccillo, Esq. McCormick, Paulding & Huber LLP CityPlace II 185 Asylum Street Hartford, CT 06103			TRUONG, THANH K	
			ART UNIT	PAPER NUMBER
			3721	
DATE MAILED: 02/02/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/616,856

Applicant(s)

KRUSE, OLAF

Examiner

Thanh K. Truong

Art Unit

3721

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 December 2005.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,6 and 11-13 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1,6 and 11-13 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 09 July 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. This action is in response to applicant's amendment received on December 7, 2005.
2. Applicant's cancellation of claims 2-5 and 7-10 is acknowledged.

Drawings

3. The drawings are objected to under 37 CFR 1.83(a). **The drawings must show every feature of the invention specified in the claims.** Therefore, the "plug socket" (claims 1, 12 and 13) must be shown **or the feature(s) canceled from the claim(s).** No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner,

the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1, 6 and 11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The phrase "having a primary mechanical utility" in the preamble of claim 1 is vague and indefinite, because:

It is unclear whether the phrase is a claim limitation or a functional description of the tool?

a) If it is a claim limitation, there is no support for this structure limitation in the body of the claim (claim 1). In other words, the body of the claim needs to include the "primary mechanical utility", regardless of what ever it is. Furthermore, without claiming the "primary mechanical utility" in the body of claim 1, the only mechanical utility being claimed is the generator, which is driven by the combustion engine.

b) If it is intended to be a function language to describe the function of the tool, no patentable weight is giving to the phrase "having a primary mechanical utility".

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1, 6 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Scott et al. (5,705,917).

Scott discloses an apparatus comprising:

a combustion engine drive (12);

a generator (14) for supplying voltage to an internal electrical consumer, the generator having a connection (702) for attachments for an external electrical consumer;

wherein the connection for attachments is a plug socket (702) that is arranged in one of a housing of the hand-held machine and a flexible cable (figure 5A shows a flexible cable between element 501 and element 703) affixed to the housing.

Scott further discloses: the connection for attachments is a plug socket (702); the connection for attachment is capable of inductive energy transfer (electric generator); the electronic component is a switch (figure 1 shows a switch on the housing of the generator unit 14); the electronic component (706) is a rectifier element (figure 7B); the electronic component is an overvoltage protection element (501); and wherein a lamp may be connected to the connection for attachment by means of a plug via a lead (column 1, line 33).

The examiner construes that the machine tool disclosed by Scott et al. is a hand-held machine tool that has primary mechanical utility (the combustion engine mechanically drives the generator to energize power tool and provides electrical power to other external electrical consumer as well - column 1, line 33-35).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nagashima (4,654,970) in view of Scott et al. (5,705,917).

Nagashima discloses an apparatus comprising: a combustion engine (column 2, lines 14-17);

a generator operatively connected to the combustion engine for supplying power to an integral electrical device disposed within a housing of the chain saw (figure 1 and column 2, lines 45-54).

Nagashima discloses the claimed invention, but does not expressly disclose a plug socket that is accessible through the housing for supplying power to an external accessory.

As discussed above in paragraph 7 of this office action, Scott discloses a plug socket (702) that is accessible through the housing of a generator for supplying power

to an external accessory (column 1, line 33). Scott's generator plug socket provides a means to connect the power supply source to an external electrical consumer.

Therefore, it would have been obvious to one having ordinary skill in the art, at the time applicant's invention was made, to have modified Nagashima's apparatus so that it have plug socket as taught by Scott to provide a means to connect the power supply source to an external electrical consumer.

10. Claims 1, 6 and 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nagashima (4,654,970) in view of Leininger (4,678,922) and further in view of Scott et al. (5,705,917).

Nagashima discloses an apparatus comprising: a combustion engine and a generator for supplying voltage to an electrical consumer; the generator has a connection for attachments for an external consumer (figure 1 and column 2, lines 49-54). Nagashima further discloses that the connection for attachment of one electronic component is arranged in the housing of the hand-held machine tool (column 2, lines 45-49).

Nagashima discloses the claimed invention, but does not expressly disclose that a lamp may be connected to the connection for attachment by means of a plug via a lead (as in claim 11).

Leininger discloses (figure 1) an apparatus comprising an air power hand tool with generator to energize a lamp 28, which is connected to the power tool via a flexible cable 30, affixed to the housing of the hand-held machine tool providing light to the work

area. Therefore, it would have been obvious to one having ordinary skill in the art, at the time applicant's invention was made, to have modified Nagashima apparatus by connecting the lamp to the generator of the hand-held machine tool as taught by Leiniger to provide light at the working area.

The modified Nagashima discloses the claimed invention, but does not expressly disclose: the connection for attachments is a plug; a plug socket with a protective cover; an electronic component is a switch, a rectifier element, and an overvoltage protection element.

As discussed above in paragraph 7 of this office action, Scott discloses a plug socket (702) that is accessible through the housing of a generator for supplying power to an external accessory (column 1, line 33). Scott's generator plug socket provides a means to connect the power supply source to an external electrical consumer.

Therefore, it would have been obvious to one having ordinary skill in the art, at the time applicant's invention was made, to have modified Nagashima's apparatus so that it have plug socket as taught by Scott to provide a means to connect the power supply source to an external electrical consumer.

In light of the applicant's amendment received on December 7, 2005, the following are the new grounds of rejection:

11. Claims 1, 6 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Steele (4,870,811).

Steele discloses an apparatus comprising:

a combustion engine drive (32);

a generator (34) for supplying voltage to an internal electrical consumer, the generator having a connection (19) for attachments for an external electrical consumer;

wherein the connection for attachments is a plug socket (19) that is arranged in one of a housing of the hand-held machine and a flexible cable (not shown – the examiner construes that there is at least one cable inside the machine to connect the generator to the plug socket to deliver the electrical energy) affixed to the housing.

Steele further discloses: the connection for attachments is a plug socket (19); the connection for attachment is capable of inductive energy transfer (electric generator); the electronic component is a switch (figure 4 shows a switch (25)); the electronic component (28, 29) is a rectifier element (figure 3); the electronic component is an overvoltage protection element (24, 26); and wherein a lamp may be connected to the connection for attachment by means of a plug via a lead (the last line of the abstract).

12. Claims 1, 6 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Welsch (5,563,774) in view of Steele (4,870,811).

Welsch discloses an apparatus (Fig 1) comprising:

a combustion engine drive (14);

a generator (12) for supplying voltage to an internal electrical consumer, the generator having a connection for attachment (20) for an external electrical consumer (18), and a flexible cable (40) affixed to the housing.

Welsch discloses the claimed invention, but it does not expressly disclose a plug socket, electronic components as recited in claim 1.

As discussed above in paragraph 8 of this office action, Steele discloses the plug socket, electronic components, as recited in claim 1, providing a convenience means to connect and disconnect the external electrical consumer from the generator outlet.

The modified Welsch by Steele further disclose: the connection for attachments is capable of inductive electrical energy transfer (as in claim 6) and a lamp (18) may be connected to the connection for attachment by means of a plug via a lead (Steele taught that a external electrical consumer (15) may be connected by means of a plug (19) via a lead – see figure 1 of Steele).

Therefore, it would have been obvious to one having ordinary skill in the art, at the time applicant's invention was made, to have modified Welsch apparatus so that it have plug socket as taught by Steele to provide a convenience means to connect and disconnect the power supply source to an external electrical consumer.

Response to Arguments

Applicant's arguments filed December 7, 2005 have been fully considered but they are not persuasive.

13. In response to the Applicant's argument regarding the Drawing Objections in the Office action of July 8, 2005, the examiner would like to point out that the objection is directed to the **DRAWING** (not the disclosure in the specification). As recited in the paragraph 3 above in this office action: "**The drawings must show every feature of**

the invention specified in the claims. Therefore, the “plug socket” (claims 1, 12 and 13) must be shown **or the feature(s) canceled from the claim(s)**”.

14. In response to the Applicant’s argument that Scott ‘917 machine tool is not considered as a hand-held machine tool having a mechanical utility, the examiner respectfully disagrees.

The light weight and portable generator (abstract) of Scott ‘917 is construed as a hand-held machine tool because it is designed as such, light weight, portable and for carrying around (it is provide with a shoulder strap (18) - see figure 1). Furthermore, it is a machine having a mechanical utility, because it mechanically (combustion engine) converts energy from liquid fuel form to electrical energy (utility – electrical generator). To further emphasize this point, the examiner states that even if the machine tool in Scott ‘917 is being used as a paperweight, it has a mechanical utility.

15. In response to the Applicant’s argument that “Scoot,...fails to teach a primary mechanical utility besides generating electricity. For example, one embodiment of the present invention has the primary mechanical utility besides generating electricity of sawing”, the examiner respectfully disagrees. As pointed out above in paragraph 3 of this office action, the Applicant fails to claim the “primary mechanical utility” in the body of claim 1 and thus the 112, second rejection (see paragraph.

Furthermore, Applicant misinterprets the principle that claims are interpreted in the light of the specification. Although the elements “the chain saw” are found as examples or embodiments in the specification, they were not claimed explicitly. Nor were the words that are used in the claims defined in the specification to require these

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limitations. A reading of the specification provides no evidence to indicate that these limitations must be imported into the claims to give meaning to disputed terms. *Constant v. Advanced Micro-Devices, Inc.*, 7 USPQ2d 1064.

16. In response to Applicant's argument that there is no suggestion to combine the references, the Examiner recognizes that references cannot be arbitrarily combined and that there must be some reason why one skilled in the art would be motivated to make the proposed combination of primary and secondary references. *In re Nomiya*, 184 USPQ 601 (CCPA 1915). However, there is no requirement that a motivation to make the modification be expressly articulated. The test for combining references is what the combination of disclosures take as a whole would suggest to one of ordinary skill in the art. *In re McLaughlin*, 110 USPQ 209 (CCVA 1971). References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures. *In re Bozek*, 163 USPQ 545 (CCPA. 1969).

In this case, Scott '917 is relied upon to demonstrate that it is known in the art to supply an electrical outlet in the form of a socket to provide a means to connect the power supplier and the electrical consumer (lights or tools).

Furthermore, in response to the Applicant's argument that Scott '917 "teach away" from modifying such tools to include outlets because "Scott, being designed to supply power to power tools (column 1, line 33)", the examiner disagrees. In fact, Scott '917, column 1, line 33 recites: "to run lights or power tools" not just power tools. Accordingly, Scott '917 is not teaching away as argued by the Applicant.

17. The Applicant repeating the argument that Scott reference "teaching away", but fails to provide any proofs or logical argument to support the premise that Scott is "teaching away". Repeating that Scott is teaching away without convincing evidence to support the argument is not persuasive, thus the repeating of the response to the argument by the examiner.

Furthermore, it is old and well known in the art to provide means to connect the electrical power source to the external electrical consumer device, and Scott clearly demonstrates the teaching of providing an outlet in the form of the plug socket.

18. In response to the Applicant's argument that "Nagashima never teaches or even suggests the desirability of including a plug socket", the examiner would like to point out that Nagashima was relied upon for teaching of a combustion engine that drives a chain saw and also the generator to provide electrical power to run other electrical consumer devices, such as electrical heater.

19. In response to Applicant's argument that the Examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. *In re McLaughlin*, 443 F.2d 1392; 170 USPQ 209 (CCPA 1971).

Conclusion

20. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

21. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

22. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thanh K. Truong whose telephone number is 571-272-4472. The examiner can normally be reached on Mon-Thru 8:00AM - 6:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi Rada can be reached on 571-272-4467. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

tkf
January 29, 2006.



Stephen F. Gerrity
Primary Examiner